

REMARKS

At the time of the Office Action dated January 11, 2008, claims 1-19 were pending in this application. Applicants acknowledge, with appreciation, the Examiner's indication that claims 3 and 4 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

In this Amendment, claims 1, 7, 9, 11, and 13 have been amended to include the limitations recited in claims 2, 8, 10, 12, and 14, respectively, and claims 2, 8, 10, 12, and 14 canceled. Entry of the present Amendment and Remarks, and favorable consideration, are respectfully solicited pursuant to the provisions of 37 C.F.R. §1.116.

Claims 1, 3-7, 9, 11, and 13 are now active in this application, of which claims 1, 7, 9, 11, and 13 are independent.

Claims 1, 7, 9, 11, and 13 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Hiroshi in view of Munemoto et al.

This rejection has been rendered moot by the amendments to independent claims 1, 7, 9, 11, and 13 to include the limitations recited in dependent claims 2, 8, 10, 12, and 14, respectively. Applicants, therefore, respectfully solicit withdrawal of the rejection of the claims.

Claims 2, 5-6, 8, 10, 12, and 14-19 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Hiroshi in view of Munetomo et al., and further in view of Shibasaki.

Because the independent claims 1, 7, 9, 11, and 13 now include the limitations recited in dependent claims 2, 8, 10, 12, 14, respectively, Applicants argue that the applied combination of

Hiroshi, Munetomo et al., and Shibasaki does not teach the claimed subject matter for the reasons set forth below.

The Examiner admitted that the combination of Hiroshi and Munetomo et al. does not explicitly teach a printing system wherein a preview image is created based on a position in which a slip sheet is to be inserted. However, the Examiner asserted that Shibasaki teaches the missing feature of the combination of Hiroshi and Munetomo et al., and concluded that it would have been obvious to modify the combination of Hiroshi and Munetomo et al. based on the teachings of Shibasaki to arrive at the claimed subject matter.

Applicants submit that Hiroshi, Munetomo et al., and Shibasaki, either individually or in combination, do not disclose or suggest a printing system including all the limitations recited in independent claim 1. Specifically, the applied combination does not teach, among other things, the following limitations:

(b-6) a slip sheet feed section specifying element for specifying one of said plurality of paper feed sections for feeding a sheet to be used as said slip sheet; and

said image creating element creates said preview image, based on said position in which said slip sheet is to be inserted which is specified by said position specifying element, and said identification information defined by said information defining element for said paper feed section specified by said slip sheet feed section specifying element.

The image creating element can create a preview image based on an insertion position of a slip sheet and identification information. Since the slip sheet may be inserted between printed sheets, it functions as a separator to separate a sheet from another, and also has a function of preventing undried ink from being transferred from printed sheets to others. The disclosed subject matter can provide a preview image so that an operator can visually recognize the insertion position of an slip sheet having the above functions.

The Examiner asserted that Hiroshi teaches a slip sheet feed section specifying element for feeding a sheet to be used as a slip sheet. Hiroshi describes a printing system in which plural types of printing media, e.g., form sheet, are set in a printer, and in printing, a desired printing medium is selected from among printing media (column 1, lines 7-11). The form sheets are different in sheet size and type of sheet (regular sheet, cardboard, envelope, postcard) (see column 1, lines 15-21). Hiroshi is silent on slip sheets. For example, Hiroshi describes that an instruction is sent to select a form sheet to be used for printing from among those form sheets in the printer (column 4, lines 7-9). However, Hiroshi does not indicate that the form sheet selected is a slip sheet. Applicants emphasize that such modification of Hiroshi without any support results in a strong indication of a hindsight reconstruction of the claimed subject matter based on the use of Applicants' disclosure as a template. Accordingly, Hiroshi does not teach, among other things, “a slip sheet feed section specifying element for specifying one of said plurality of paper feed sections for feeding a sheet to be used as said slip sheet,” as recited in claim 1.

Shibasaki teaches displaying a preview of print data for every specific color. Applicants specifically note that a “Blank Sheet” in INPUT DATA FILE 2 of Fig. 9 merely indicates that a print data of a specific color (red in Fig. 9) does not exist, and it is fundamentally different from the slip sheet as described above. Therefore, Shibasaki fails to teach creating a preview image based on an insertion position of the slip sheet.

The Examiner asserted, “[s]lip sheet which is scanned in becomes an image file where it can be represented by a file name such as ‘INPUT DATA FILE 2’ and the slip sheet can be correlated with any page of the print data” (see the first full paragraph on page 11 of the Office Action). However, Shibasaki does not have a paper feed section for feeding a slip sheet, and the

slip sheet feed section specifying element for specifying one of a plurality of paper feed sections for feeding a sheet to be used as a slip sheet.

Accordingly, the applied combination of the references does not teach, among other things, specifying one of a plurality of paper feed sections for feeding a sheet to be used as a slip sheet; and creating a preview image based on a position in which the slip sheet is to be inserted, and identification information.

Furthermore, it is well settled that the problem addressed and solved by a claimed invention must be given consideration in resolving the ultimate legal conclusion of obviousness under 35 U.S.C. §103. *North American Vaccine, Inc. v. American Cyanamid Co.*, 7 F.3d 1571, 28 USPQ2d 1333 (Fed. Cir. 1993); *Northern Telecom, Inc. v. Datapoint Corp.*, 908 F.2d 931, 15 USPQ2d 1321 (Fed. Cir. 1990); *In re Newell*, 891 F.2d 899, 13 USPQ2d 1248 (Fed. Cir. 1989); *In re Nomiya*, 509 F.2d 566, 184 USPQ 607 (CCPA 1975).

The present application addresses a problem “it is impossible for the operator to easily check which sheet is to be used as the slip sheet” (the paragraph bridging pages 2 and 3 of the specification). This problem is not even on Shibasaki’s apparatus, as well as Hiroshi and Munetomo et al. Accordingly, under the circumstances of this case, the problem addressed and solved by the claimed invention constitutes a potent indicium of nonobviousness.

Based on the foregoing, Applicants submit that Hiroshi, Munetomo et al., and Shibasaki, either individually or in combination, do not disclose or suggest a printing system including all the limitations recited in independent claim 1. The above discussion is applicable to independent claims 7, 9, 11, and 13. Dependent claims 5 and 6 are also patentably distinguishable over Hiroshi, Munetomo et al., and Shibasaki at least because these claims include all the limitations

recited in independent claim 1. Applicants, therefore, respectfully solicit withdrawal of the rejection of the claims and favorable consideration thereof.

Conclusion

It should, therefore, be apparent that the imposed rejections have been overcome and that all pending claims are in condition for immediate allowance. Favorable consideration is, therefore, respectfully solicited.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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